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| 10/775,411 | 02/10/2004 | Glenn Gaarder | 084061-0573 | 9748 |

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EXAMINER

MORRISON, THOMAS A

ART UNIT PAPER NUMBER

3653

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,411

Applicant(s)

GAARDER ET AL.

Examiner

Thomas A. Morrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 26-29 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-23 is/are allowed.
- 6) ☒ Claim(s) 1-2, 5, 8, 10-13, 15 and 24-25 is/are rejected.
- 7) ☒ Claim(s) 3, 4, 6, 7, 9 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-25 in the reply filed on March 10, 2005 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, there is insufficient description in the specification of the claimed means for cessating transmission of power to the first roller upon the first roller rotating at least 360 degrees after the first roller and the second roller have initially and simultaneously engaged a media sheet.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8, 15, 24 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, it is unclear from the language of claim 8, as to the structural relationship between the recited elements. What structural relationship between the claimed elements (e.g., first dwell mechanism surface, third dwell mechanism surface, first roller and second roller) allows the first dwell mechanism surface to disengage the third dwell mechanism surface?

Regarding claims 15 and 24, these claims recite that the second gear moves between the first and second positions. This appears to be inaccurate. Rather, it appears that the third gear moves between first and second positions.

Regarding claim 25, it is unclear if the means for cessating transmission of power to the first roller only operates after the first roller rotates at least 360 degrees or the the means for cessating transmission of power to the first roller operates any time including a time after the first roller rotates at least 360 degrees.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 25, as best understood, is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,168,147 (Nose et al.). In particular, Nose et al. meets all of the limitations of claim 25.

Regarding claim 25, Fig. 1 shows a sheet transfer apparatus including

a first roller (6) configured to be rotatably driven at a first surface speed;

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a second roller (3) spaced from the first roller (6) such that the first roller (6) and the second roller (3) are configured to simultaneously engage a media sheet, the second roller being configured to be driven at a second surface speed greater than the first surface speed (see column 1, lines 36-42); and

means for cessating transmission of power (10) to the first roller (6) upon the first roller rotating after the first roller (6) and the second roller (3) have initially and simultaneously engaged a media sheet. (See, e.g., column 4, lines 37-48). Also, Nose et al. discloses that means for cessating transmission of power (10) to the first roller (6) operates when overfeeding of a sheet occurs. (See, e.g., column 4, lines 41-47). Interpreted broadly, this can mean that the means for cessating transmission of power (10) to the first roller (6) can operate any time overfeeding of a sheet occurs. Accordingly, such operation can occur after the first roller (6) rotates at least 360 degrees, as set forth in claim 25.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 5, 10 and 12-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,666,446 (Gaarder et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because spacing the second roller from the first roller such that the first roller and the second roller are configured to simultaneously engage a media sheet would have been obvious. Also, it would have been obvious for the third gear to remain in the first position upon the first roller and the second roller simultaneously engaging the media sheet.

6. Claim 11 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,666,446 (Gaarder et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because spacing the second roller from the first roller such that the first roller and the second roller are configured to simultaneously engage a media sheet would have been obvious.

7. Claims 1, 2, 10 and 12-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,581,924 (Gaarder et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because spacing the second roller from the first roller such that the first roller and the second roller are configured to simultaneously engage a media sheet would have been obvious.

8. Claim 11 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the combination of claims 8 and 9 of

U.S. Patent No. 6,581,924 (Gaarder et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because spacing the second roller from the first roller such that the first roller and the second roller are configured to simultaneously engage a media sheet would have been obvious.

9. Claims 1, 5, 10 and 12-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of U.S. Patent No. 6,874,776 (Gaarder et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because spacing the second roller from the first roller such that the first roller and the second roller are configured to simultaneously engage a media sheet would have been obvious.

10. Claim 11 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 of U.S. Patent No. 6,874,776 (Gaarder et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because spacing the second roller from the first roller such that the first roller and the second roller are configured to simultaneously engage a media sheet would have been obvious.

11. Claims 1, 5, 10 and 12-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of copending Application No. 10/633,126. Although the conflicting claims are not identical, they are not patentably distinct from each other because spacing the second roller from the first roller such that the first roller and the second roller are configured to simultaneously engage a media sheet would have been obvious. Also, it would have

been obvious for the third gear to remain in the first position upon the first roller and the second roller simultaneously engaging the media sheet.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claim 11 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of copending Application No. 10/633,126. Although the conflicting claims are not identical, they are not patentably distinct from each other because spacing the second roller from the first roller such that the first roller and the second roller are configured to simultaneously engage a media sheet would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

13. Claims 16-23 are allowed. Claims 3-4, 6-7, 9 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on (571) 272-6944. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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